

The Statutory Restriction Standard Has Not been Met

The Patent statute states:

"If two or more independent and distinct inventions are claimed in one application, the Commissioner MAY require the application to be restricted to one of the inventions." (Emphasis supplied, 35 USC 121)

The standard requires that the allegedly multiple inventions be "independent and distinct". This standard has not been met. The examiner has not even alleged that the subject matter of Formulas I, III, and IV is independent and distinct. Neither has the Examiner cited any evidence that would lead one to believe that the subject matter of Formulas I, III, and IV is independent and distinct. The burden of proof is on the Examiner. The statutory standard has not been met.

Applicant Has a Right to Define His Invention

By requiring the restriction, applicants are deprived of their statutory rights under 35 USC 112 to have "claims particularly pointing out and distinctly claiming the subject matter which applicant regards as his invention." (Emphasis supplied). The Examiner has, in effect, carved out a portion of applicant's invention and rejected it under the guise of a restriction requirement under 35 USC 121. This the Examiner may not do. The

Court of Customs and Patent Appeals has ruled that any attempt by the PTO to reject a single claim as embracing more than one invention under 35 USC 121 violates the basic right of applicants to claim their inventions as they choose. In re Weber, 198 USPQ 328, 331-32 (CCPA 1978); In re Haas, 198 USPQ 334, 336 (CCPA 1978).

The Search Here Does Not Impose a Serious Burden

The Manual of Patent Examining Procedure ("MPEP") states:

"If the search and examination of an entire application can be made without serious burden, the Examiner must examine it on the merits, even though it includes claims to independent or distinct inventions" (MPEP Sec. 803, July 1988)

There is no serious burden here. As far as the record shows all allegedly independent and distinct inventions fall into a single subclass. The Examiner has made no showing that searching a single subclasses is a "serious burden". The burden of proof to show "serious burden" is on the Examiner. This burden has not been met.

Applicant Has Paid for Examination of All Claims

Having paid an application fee, the applicant is entitled to have the Examiner determine the novelty and non-obviousness of the subject matter claimed. If the position of the Examiner be accepted, applicants will be burdened with the expense of several

additional applications. These expenses include government filing fees, issue fee and maintenance fees in addition to attorneys fees and the value of the time that the inventor and others will necessarily spend during prosecution.

Restriction is Discretionary

Even if the statutory standard has been met, discretion should be exercised in this case and restriction not required for the reasons given herein.

Provisional Election

A provisional election is made with traverse of claims 1 through 6 inclusive and claims 13 through 18 inclusive. The Examiner has not restricted between claims but rather between formulas I, III, and IV. All provisionally elected claims read on the compounds of formula I and do not read on either those of formula III or IV. The species of claim 6 is the presently preferred species.

Notwithstanding this provisional election an action of all pending claims on the merits is respectfully requested.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully

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requested to contact David R. Murphy (Reg. No. 22,751) at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.


If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

BIRCH, STEWART, KOLASCH & BIRCH, LLP

By 
Gerald M. Murphy, Jr., #28,977

P.O. Box 747
Falls Church, VA 22040-0747
(703) 205-8000


GMM/DRM/jmb
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